

REMARKS

The specification has been amended at page 1 to alert the Examiner to twenty-four our related co-pending applications. Original claims 1-51 remain in the application.

Claims 1-4, 9, 10, 15-17, 23-25, 27-30, 33, 34, 41-48, and 50 are rejected for anticipation by US Patent No. 5,848,397 ("Marsh"). That rejection is respectfully traversed for the following reasons.

Rejection of a claim for anticipation by a reference requires that the reference describe, explicitly or inherently, all steps or elements of the rejected claim, and all limitations thereof.

Taking claim 1 as representative, a method of operating a client device is recited that includes:

"effecting an advertisement download communication link between the client device and an advertisement distribution server system, via the communications network, at selected advertisement download times;

effecting a data communication link with a data communications service provider, via the communications network, wherein the advertisement download communication link and the data communication link are separate communication links;

downloading advertisements from the advertisement distribution server system via the advertisement download communication link;

storing downloaded advertisements on a storage medium associated with the client device; and

displaying at least selected ones of the stored advertisements, in accordance with ad display parameters prescribed by the advertisement distribution server system."

According to claim 1, a client device is operated by effecting an advertisement download communication link with an advertisement distribution server system and a *separate* data communication link with a data communications service provider. The proposal in the Office Action at page 2, section 2, is that such separate links are taught in Marsh at FIG. 4 and column 3, lines 28-37. The applicants respectfully disagree.

Initially it is noted that the Office Action offers no explanation of how these two links are taught in the cited portions of Marsh, and what constitutes disclosure that they are separate. In this regard, FIG. 4 of Marsh is a "video display mock-up" showing a preferred placement of advertisements. This figure is described at column 7, line 40 through column 8, line 30. The figure shows a banner ad 601 and a showcase ad 1001. Both are stored and displayed at a client computer 101. However, as FIGS. 1 and 8 of Marsh illustrate, the client computer 101 is served by a *single* server system 104. This server system is constituted of e-mail servers.

Marsh, at column 3, lines 28-37 describes an advertisement download scheduler; however, this element is "located at the server system 104" (Marsh column 15, lines 31, 32). Furthermore, Marsh does not disclose the source of advertisements that are subject to management by the advertisement download scheduler. That is to say, Marsh shows no "advertisement distribution server system" that is separate from the e-mail server system 101. Indeed, it appears that e-mail and advertisement services are both obtained from a single server system in Marsh. Since there is no advertisement distribution server system taught in Marsh, Marsh necessarily omits the step of "effecting an advertisement download communication link between the client device and an advertisement distribution server system" in combination with the step of "effecting a data communication link with a data communications service provider" where "the advertisement download communication link and the data communication link are separate communication links". Accordingly, Marsh does not anticipate claims 1-4, 9, 10, 15-17, 23-25, 27-30, 33, 34, 41-48, and 50.

Claims 5-8, 11-14, 18-22, 26, 31, 32, 35-40, and 51 are rejected for obviousness over Marsh. That rejection is respectfully traversed for the following reasons.

Claims 5-8, 11-14, 18-22, 26, 31, 32, and 35-40 depend from claim 1 and therefore include the combination of "effecting an advertisement download communication link between the client device and an advertisement distribution server system" in combination with the step of "effecting a data communication link with a data communications service provider" where "the advertisement download communication link and the data communication link are separate communication links"; claim 51 also includes this combination. As already pointed out, Marsh omits this combination.

In addition, as admitted in the Office Action, Marsh further omits "the maximum number of times per day that each stored advertisement is to be displayed and the date/time before which each stored advertisement is to be displayed and the end date/time after which each stored advertisement should not be displayed." Nevertheless, Official Notice is taken that it is "old and well known in advertisements/marketing to make certain determinations" such as those recited in claims 5-8, 11, 12, 26, 31, 32, and 51 "in order to better target the correct time for advertisements." The applicants respectfully submit that such is not the case. Advertising by communication with computers is unique in advertising/marketing. The communication channel to a computer provides the ability to exchange information, including advertising, as well as the ability to conduct sales transactions and distribute goods and services. The ad audience size is the currency of advertising media. Managing ad display and life time are therefore very important functions. Advertising scheduling for computer users is an evolving discipline,

involving critical issues. As Marsh points out, advertisers “run the risk of users being numbed or otherwise negatively affected by their advertising as the result of overexposure.” Marsh, column 2, lines 54-56. The applicants have a further concern: scheduling of ads delivered in batches to client device software. In this regard, “it is unlikely that either the software provider or the client software will be able to derive a significant benefit from the ad scheduling algorithms currently run on ad services. This is in part due to the fact that the ads being displayed by the e-mail client software are divorced from the content being displayed, i.e., neither the software provider nor the client software are cognizant of the content of any particular ad that the user is looking at, and in part due to the fact that the e-mail client software will be requesting ads in a batch for later display, rather than requesting them in “real time”. Specification page 38, lines 17-28. Accordingly, the applicants submit that the parameters recited in claims 5-8, 11, 12, 26, 31, 32, and 51 are not of such “notorious character” that Official Notice can be taken of them. The applicants therefore respectfully request citation of a supporting reference. MPEP 2144.03, second paragraph. Otherwise, the rejection of claims 5-8, 11, 12, 26, 31, 32, and 51 should be withdrawn.

For reasons similar to those detailed above in respect of claims 5-8, 11, 12, 26, 31, 32, and 51, the applicants also request citation of a reference to support the Official Notice taken in support of the rejection of claims 13 and 14. Otherwise, the rejection of these claims should be withdrawn.

In support of the rejection of claims 18-22 and 35-40, it is contended that Marsh at column 3, lines 28-36 teaches both “a face time duration parameter” and the step of “displaying” a selected advertisement “for the face time duration” prescribed by the associated face time parameter. The applicants respectfully disagree. The “face time” parameters relate to the time a user is “present and accounted for” when an ad is displayed. Specification, page 35, lines 20-25. The cited passage of Marsh describes an advertisement download scheduler that manages when advertisements are transmitted to a user, that transfers high priority advertisements first, and that manages the number of advertisements transmitted at any given time to reduce unnecessary user wait time. No mention is made of “a face time duration” parameter or of a step of displaying an advertisement for a face time duration. Finally, determination of face time by measuring user activity is deemed obvious because of Marsh’s logging of statistics described at column 14, line 66 through column 15, line 7. In fact this passage describes logging the duration of ad display, which may or may not correspond to “face time”. Nothing in this passage describes a time period of any kind based on detection of user activity. In fact the one mention of user activity at column 15, lines 14-20 only describes logging user activity in an “event file”.

But there is no relationship between the entries in this event file and displaying an ad for a "face time" duration comprising a period of user activity. Accordingly, Marsh omits steps and limitations recited in claims 18-22 and 35-40. The rejection therefore does not meet the "all elements" requirement of *prima facie* obviousness. See MPEP 2142, et seq.

Thus, in view of the remarks made in this paper, it is submitted that the claims in this application define subject matter that is patentably distinct from the references of record, early notice of which is earnestly solicited.

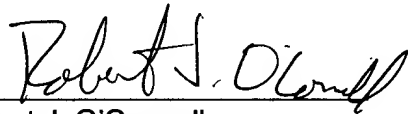
CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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